

### **Remarks**

Claims 1-6 are in the application of which claims 1, 4, and 5 are in independent form. Claims 1-6 are subject to a species restriction under 35 U.S.C. § 121, in response to which Species II (FIG. 3) was previously provisionally elected in the Amendment filed October 7, 2005.

The Office action dated May 12, 2006 follows a request for continued examination (RCE) including minor clarifying amendments. In the May 12, 2006 Office action, the previous grounds for rejection over Wolfe (US 2,532,981) have now been withdrawn in view of new grounds for rejection and newly-cited prior art.

Applicant thanks the examiner for the courtesy of a telephone interview on July 24, 2006, during which the operation of the device of Zimmermann (US 6,345,686) was discussed. The arguments set forth below encompass the substance of the points presented to the examiner during the telephone interview.

#### ***Rejections under 35 U.S.C. § 103(a)***

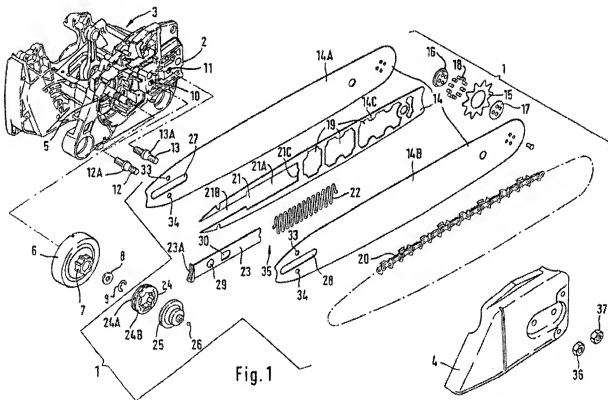
Claims 1, 3, 4, and 5 now stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. patent No. 5,345,686 of Zimmermann in view of U.S. Patent No. 2,532,981 of Wolfe. Claims 2 and 6 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Zimmermann in view of Wolfe and U.S. Patent No. 3,039,337 of Stuart-Prince. Applicant respectfully traverses and requests reconsideration in view of the following remarks.

The Office action fails to identify in the cited references or the knowledge of persons skilled in the art any motivation or suggestion for the combination of Zimmermann and Wolfe. The Office action states that “It would have been obvious to a person of ordinary skill in the art to provide Zimmermann’s chain saw bar with latch and recess [as taught by Wolfe] in order to rigidly lock the sliding member at a pre-selected location and avoid movement of sliding member that may change the tension of the chain saw during the use.” However, neither Zimmermann nor Wolfe teaches that it might be desirable to prevent a change in the tension of the saw chain during use. In fact, one of the purposes the devices of Zimmermann and Wolfe (and of the present invention) is to actively tension the saw chain during use by a spring to bias the idler sprocket away from the drive sprocket. (See Zimmermann at column 2, lines 42-54). The Office action therefore presents a rationale for the combination of

Zimmermann and Wolfe that is directly contrary to the problem purportedly solved by Zimmermann.

The Office action also fails to assert that persons skilled in the art would have been motivated to lock the sliding member at a pre-selected location to prevent a change in the tension of the saw chain. Nor could the Office make such an assertion, since it would be antithetical to the primary purpose of a spring-biased tensioning device. Tensioning devices of the kinds disclosed by Zimmermann, Wolfe, and others are generally intended to eliminate the need to adjust the chain tension during installation and to monitor and adjust the chain tension in response to wear of the chain, bar, or sprockets. Locking the sliding member at a pre-selected location during use, as suggested by the Office action, would effectively disable the tensioning mechanisms.

Moreover, adding a latch to Zimmermann's chain saw bar would render the device inoperable. For the examiner's convenience, Figure 1 of Zimmermann is reproduced below.



If the slide 23 of Zimmerman were rigidly locked at a pre-selected location relative to the guide bar 14, as suggested in the Office action at page 3, then two important functions of the Zimmerman device would be disabled. A first function, described at column 4, lines 12-42 of

Zimmermann, involves sliding movement of guide 23 in cooperation with the biasing force of spring 22 to enable the cutting arrangement 1 (including guide bar 14, chain 20, and sprocket drive wheel 24, among other parts) to be held together in a tensioned arrangement as a preassembled component when the bar is not yet installed on a saw housing 2. If the slide 23 of Zimmermann were rigidly locked relative to guide bar 14 prior to installation of the cutting arrangement 1 on a chain saw motor and housing 2, the slide 23 would be unable to bear against the sprocket drive wheel 24 in the manner described by Zimmermann to form a preassembled component that is readily installed on a chain saw motor housing.

Second, if the slide 23 of Zimmermann were locked during installation of the cutting arrangement 1 on the housing 2, it would prevent the openings 29 and 30 in the slide 23 from properly moving into alignment with and engaging the “thickening” portions 12A and 13A of bolts 12 and 13 so as to release the slide 23 from engagement with the sprocket drive wheel 24 for providing clearance for the rotation of the sprocket drive wheel 24, as described at column 4, lines 64 to column 5, line 20 of Zimmermann. Thus, a locked slide would interfere with the mechanism by which the slide 23 of Zimmermann is moved from its “start” position (described at column 4, lines 32-42 and 64-66 of Zimmermann) to its released position (described at column 4, line 66 to column 5, line 20), to thereby enable operation of the saw.

For at least the foregoing reasons, it is argued that the modification of Zimmermann proposed in hindsight by the Office action – namely, to add a latch of the kind taught by Wolfe – would render the preassembled tensioning device of Zimmermann unsatisfactory for its intended purposes or at least significantly change its principle of operation. MPEP § 2143.01(V) (proposed modification cannot render the prior art unsatisfactory for its intended purpose). *See also* MPEP § 2143.01(III) (fact that references can be combined or modified is not sufficient to establish *prima facie* obviousness). Consequently, the Office action fails to establish the existence of a suggestion or motivation to make the proposed change and is therefore insufficient to establish a *prima facie* case of obviousness.

Furthermore, combining Zimmermann and Wolfe to accomplish the function proposed by the examiner—i.e., to prevent a change in the tension of the saw chain during use—would result in a structure failing to meet all of the limitations of the independent claims. Wolfe describes that the purpose of the spring finger (25') is to prevent accidental removal or ejection of the plate (25) and the idler (“I”). In contradistinction, the claims recite a latch that

engages when the sliding member is forced in a direction away from the mounting stud to prevent the sliding member from moving toward the mounting stud. This feature releases the tensioning forces and allows the chain to be easily removed from the saw. In the embodiments disclosed, the arrangement of the latch relative to the path of the sliding member determines this functional element of the claims. The latch of Wolfe is located at a position along the travel of the sliding plate (25) that prevents ejection and not where it would engage when the plate 25 is forcibly depressed. Assuming *arguendo* that the latch taught by Wolfe could be applied to the structure of Zimmermann (and that a motivation for doing so existed), such a combination would at best prevent the slide 23 of Zimmermann from being accidentally removed or ejected, but would not result in the latch being positioned so as to engage when the slide 23 is forced in a direction away from the mounting stud and thereby prevent the sliding member from moving toward the mounting stud, as required by the present claims. Wolfe does not teach a latch mechanism that allows tensioning forces to be released for removing the saw chain, as in the present application. Rather, the Wolfe latch merely serves as a retainer to prevent the ejection of the sliding member, as further discussed in the Remarks section of applicant's Amendment dated March 27, 2006.

### ***Conclusion***

The Office action fails to show any suggestion in the cited prior art or the knowledge of skilled persons, in view of the prior art, for the desirability of the claimed invention or to otherwise establish a plausible motivation for combining Zimmermann and Wolfe. Nor would a combination of Zimmermann and Wolfe satisfy all of the elements of the claims. Applicant therefore submits that that the Office action fails to establish a *prima facie* case of obviousness.

Applicant believes the application is in condition for allowance and respectfully requests the same.

Applicant respectfully reminds the examiner of the guidance of the Manual of Patent Examining Procedure that:

“[t]o bring the prosecution to as speedy conclusion as possible and at the same time to deal justly by both the applicant and the public, the invention as disclosed and claimed should be thoroughly searched in the first action and the references fully applied . . . . Switching . . . from one set of references to another by the examiner in rejecting in successive actions claims of

substantially the same subject matter, will . . . tend to defeat attaining the goal of reaching a clearly defined issue for an early termination . . . .

“The examiner should never lose sight of the fact that in every case the applicant is entitled to a full and fair hearing, and that a clear issue between applicant and examiner should be developed, if possible, before appeal.”

MPEP § 706.07. In the event that the Office identifies any remaining issues that may be easily resolved, the examiner and his supervisor are invited to contact the undersigned attorney by telephone.

Respectfully submitted,

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